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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/698,962 | 10/30/2003 | James R. Casciani | 009103-009740US | 8826 |
| 20350 | 7590 | 02/10/2006 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834 | | | WINAKUR, ERIC FRANK | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3735 | |

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | |
|------------------------------|-----------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/698,962 | CASCIANI ET AL. |
| | Examiner | Art Unit |
| | Eric F. Winakur | 3735 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 December 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 60-71 is/are pending in the application.
- 4a) Of the above claim(s) 61 and 65 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 60,62-64 and 66-71 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 13 December 2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 60, 62, and 66 - 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claims 60 and 66, it is unclear what Applicant intends to define by the phrase "narrow mean wavelength" as a mean value is always a single number, i.e. it cannot be considered narrow or broad, as it is just a value. With regard to claims 60, 70, and 71, Applicant refers to a "red light spectrum" having a mean wavelength of certain ranges or values over 700 nm. However, visible light is generally considered to be between 400 and 700 nm and infrared light emissions are wavelengths above 700 nm. Thus, it is unclear why Applicant refers to an infrared wavelength as defining a "red light spectrum".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 60, 62 - 64, and 66 - 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis et al. Lewis et al. teach an oximeter arrangement that includes emitters at 735 nm and 805 nm. Without including a positively recited method step, Lewis et al. is considered to meet claim 67. With regard to claims 68 and 69, all of the wavelengths sensed by Lewis et al. are used in calculating the oxygen saturation value, regardless of the subject's saturation level. With regard to claim 71, about 735 nm (column 7, line 14) is considered to be "approximately" 730 nm.

6. Claims 60, 63, and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Tamura et al. Tamura teaches an optical measurement arrangement useful for obtaining oxygen saturation information that includes emitters for irradiating at 730 and 750 (IR) nm and a detector for measuring light after interaction with the subject.

Terminal Disclaimer

7. The terminal disclaimers filed 13 December 2005 do not comply with 37 CFR 1.321(b) and/or (c) because:

- a. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).
8. It is noted that the change of power of attorney filed 5 July 2005 was not accepted for the reasons given in the Office letter of 25 July 2005.
9. If Applicant corrects the change in power of attorney, Applicant should re-submit a photocopy of the terminal disclaimer for re-evaluation. Alternately, a newly executed terminal disclaimer signed by an individual authorized to do so may be filed.

Double Patenting

10. Claims 60, 62 - 64, and 66 - 71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3, 14, and 15 of U.S. Patent No. 6,662,033, claims 3 and 5 - 7 of U.S. Patent No. 6,272,363, and claims 8 and 9 of U.S. Patent No. 5,421,329 for the reasons of record. As noted above, the terminal disclaimers filed to overcome these rejections were not accepted.

Response to Arguments

11. Applicant's arguments with respect to claims 60, 62 - 64, and 66 - 69 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F. Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on 571/272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric F Winakur
Primary Examiner
Art Unit 3735

6 February 2006